

Application No. : 09/706,965
Amdt. Dated : December 22, 2004
Reply to O.A. of : September 22, 2004

REMARKS

The Applicants thank the Examiner for his careful examination of the present application. By way of summary, Claims 1 and 12-24 were pending in this application. In the present amendment, the Applicants have amended Claims 1, 13, 15, 17, 20, 22, and 23-24. Accordingly, Claims 1 and 12-24 are pending for consideration.

Allowable Subject Matter - Claims 13, 15, 20 and 22.

The Applicants also thank the Examiner for the indication of allowable subject matter in Claims 13, 15, 20 and 22. Pursuant to the Office Action, the Applicants have rewritten Claims 13, 15, 20 and 22 into independent form to include all of the limitations of the corresponding base claim and any intervening claims. Accordingly, the Applicants respectfully submit that amended Claims 13, 15, 20 and 22 are now in condition for allowance.

Examiner's Statement of Reasons for Allowance

The Applicants respectfully disagree with the Examiner's Statement of Reasons for Allowance if not all the claims include each of the structures or method steps recited in the Examiner's Statement. Also, to the extent that there is any implication that the patentability of any claim rests on the recitation of a single feature, the Applicants respectfully disagree with the Examiner's Statement because it is the combination of features recited in each claim that makes that claim patentable.

Rejection of Claims 1, 12, 16-19 and 23-24 Under 35 U.S.C. § 102(b) and of Claims 14 and 21 Under 35 U.S.C. § 103(a)

The Office Action rejected Claims 1, 12, 16-19 and 23-24 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 5,372,135, issued to Mendelson et al. (the Mendelson patent). In addition, the Office Action rejected Claims 14 and 21 as being unpatentable over the Mendelson patent in view of U.S. patent no. 6,529,755, issued to Higashio et al. (the Higashio patent). The Applicants respectfully traverse these rejections because the Mendelson patent, alone or in combination with the

Application No. : 09/706,985
Amdt. Dated : December 22, 2004
Reply to O.A. of : September 22, 2004

Higashio patent, fails to teach or suggest the elements of the claims. See M.P.E.P. § 2131 (stating that in order to anticipate a claim, a prior art reference must identically teach every element of the claim); see also § 2143 (stating that in order to establish a *prima facie* case of obviousness for a claim, the prior art references must teach or suggest all the claim limitations).

The Office Action reconsidered the Mendelson patent and argued that Fig. 3 includes a light beam A through a first site not affected by the compression of tissue at a second site receiving light beam B. In order to avoid confusion and subsequent argument on whether the modulation occurring at Mendelson's second test site affects the optical properties at the first test site, the Applicants have amended their non-allowed claims to specify that the light detector produces the output signal based only on light through an original test site. This is clearly not taught or suggested by Mendelson alone, or in combination with Higashio. See Col. 4:40-45. Accordingly, the Applicants submit that the Mendelson patent, alone or in combination with the Higashio patent, fails to teach or suggest all of the elements of the claims, and respectfully requests allowance of the same.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 22, 2004

By: 

John M. Grover
Registration No. 42,610
Attorney of Record
Customer No. 20,995
(949) 760-0404